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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/575,290 | 05/19/2000 | Naozumi Takenaka | 13700 | 1281 |
| 23370 7590 04/03/2008 | | | | |
| JOHN S. PRATT, ESQ. KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309 | | | | |
| EXAMINER | | | | |
| TODD, GREGORY G | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2157 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 04/03/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/575,290

Applicant(s)

TAKENAKA ET AL.

Examiner

GREGORY G. TODD

Art Unit

2157

Period for Reply
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment filed, 03 January 2008, of application filed, with the above serial number, on 19 May 2000 in which claims 16-18 have been added. Claims 9-18 are therefore pending in the application.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Added claim 18 teaches "the authentication information is transmitted to two or more portable terminals to authenticate the requested information sent to each portable terminal", however, the specification, and in particular, the quoted supported section of the specification (p. 3:5-4:22; p. 7:1-3; and Fig. 6) does not support and have antecedent basis for the quoted terminology.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geiger et al (hereinafter "Geiger", 6,463,534) in view of Mankoff (hereinafter "Mankoff", 2002/0116271).

As per Claim 9, Geiger teaches a service providing system comprising:

- a network having

- an information providing server which provides information (at least col. 10, lines 55-64; col. 13, lines 13-42; eg. third party or merchant server), and

- an authentication server capable of sending and receiving information to and from the information providing server (at least col. 10, lines 38-64; col. 12, lines 19-31; validation server for server authentication); and

- a portable terminal capable of sending and receiving information to and from the network (at least col. 8, lines 28-45; wireless client device connecting to network);

- wherein the information providing server is configured to send to the authentication server information requested by the portable terminal, address information associated with the information providing server, and tag information (at least col. 10, lines 38-64; col. 12, lines 19-31; cross certificates for server authentication, in addition to keys);

- wherein the authentication server has an authentication information database which stores authentication information which specifically identifies the information providing server (at least col. 13, lines 10-23; validation server);

wherein the authentication server has a detector which detects the tag information (at least col. 10, lines 38-54; cross certificates for server authentication, in addition to keys);

wherein the authentication server has a transmitter which sends to the portable terminal the requested information sent by the information providing server and the authentication information retrieved from the authentication database when the tag information is detected and the address information matches information stored in the authentication database (at least col. 13, lines 13-67; delivering content to client); and

wherein the portable terminal has a first display area which displays the requested information sent by the information providing server (at least col. 13 line 66 - col. 14 line 8).

Geiger fails to explicitly teach a second display area which displays only the authentication information, and the authentication information can not be edited by the portable terminal. However, the use and advantages for displaying such information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mankoff. Mankoff teaches a mobile device such as a PDA connecting to a coupon/ticket server and downloading and displaying an unalterable digital image/code/watermark (at least paragraph 30-32; claim 18; Fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile device of Geiger to display requested information and have that information be valid and unalterable by using a digital coupon/watermark information as taught by Mankoff. Using the known technique of an unalterable digital

image/watermark to protect the validity of provided information in the provided information of Geiger would have been obvious to one of ordinary skill.

As per Claim 10. The service providing system of Claim 9, wherein the portable terminal further includes a radio transmitter to access the network via wireless communication (at least col. 8, lines 28-45).

As per Claim 11, Geiger teaches a service providing method using a portable terminal which can be connected to a network having an information providing server and an authentication server, the method comprising:

- the portable terminal accessing the network to request information (at least col. 8, lines 28-45; wireless client device connecting to network);

- the information providing server transmitting to the authentication server the information requested by the portable terminal, address information for the information providing server, and tag information (at least col. 10, lines 38-64; col. 12, lines 19-31; cross certificates for server authentication, in addition to keys);

- the authentication server detecting the received tag information (at least col. 10, lines 38-54; cross certificates for server authentication, in addition to keys);

- the authentication server retrieving authentication information when the tag information is detected and the received address information matches information stored in the authentication server, and sending the requested information sent by the information providing server and the authentication information to the portable terminal (at least col. 13, lines 13-67; delivering content to client and viewing of the certificate by the user); and

the portable terminal displaying the requested information on a first display area (at least col. 13 line 66 - col. 14 line 8)

Geiger fails to explicitly teach a second display area which displays only the authentication information, and the authentication information can not be edited by the portable terminal. However, the use and advantages for displaying such information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mankoff. Mankoff teaches a mobile device such as a PDA connecting to a coupon/ticket server and downloading and displaying an unalterable digital image/code/watermark (at least paragraph 30-32; claim 18; Fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile device of Geiger to display requested information and have that information be valid and unalterable by using a digital coupon/watermark information as taught by Mankoff. Using the known technique of an unalterable digital image/watermark to protect the validity of provided information in the provided information of Geiger would have been obvious to one of ordinary skill.

As per Claim 12. The service providing method of Claim 11, wherein the portable terminal accesses the network via wireless communication (at least col. 8, lines 28-45; wireless).

As per Claim 13. The service providing system of Claim 9, wherein the portable terminal further comprises one from the group consisting of a mobile phone, personal computer, and personal digital assistant (at least col. 8, lines 28-45; wireless client device

connecting to network).

As per Claim 14, Geiger teaches the service providing system of Claim 13, wherein:
the requested information identifies an event (at least col. 14, lines 1-8; concert ticket).

Geiger fails to explicitly teach the combination of the requested information and the authentication information serve as an electronic ticket to the event. However, the use and advantages for displaying such information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mankoff.

Mankoff teaches a mobile device such as a PDA connecting to a coupon/ticket server and downloading and displaying an unalterable digital image/code/watermark (at least paragraph 30-32; claim 18; Fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile device of Geiger to display requested information and have that information be valid and unalterable by using a digital coupon/watermark information as taught by Mankoff to provide a valid unalterable ticket. Using the known technique of an unalterable digital ticket to protect the validity of provided information in the provided information or ticket to a concert (col.14, lines 1-8) of Geiger would have been obvious to one of ordinary skill.

As per Claim 15. Geiger fails to explicitly teach wherein the authentication information further comprises alpha-numeric text to uniquely identify the information providing server. However, the use and advantages for displaying such information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mankoff. Mankoff teaches a mobile device such as a PDA connecting to a

coupon/ticket server and downloading and displaying an unalterable digital image/code/watermark/checksum or the like (at least paragraph 30-32; claim 18; Fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the mobile device of Geiger to display requested information and have that information be alpha-numeric and unalterable by using a digital image/code/watermark/checksum or the like, as taught by Mankoff to provide a valid unalterable ticket. Using the known technique of an unalterable digital ticket to protect the validity of provided information in the provided information or ticket to a concert (col.14, lines 1-8) of Geiger would have been obvious to one of ordinary skill.

As per Claim 16. The service providing system of Claim 9, wherein the authentication information further comprises an IP address to uniquely identify a location of the information providing server on the network (at least col. 14:53-55; IP addresses).

As per Claim 17. The service providing system of Claim 9, wherein the requested information further comprises a date, time, and location to uniquely identify an event (at least col. 13:66-14:5; ticket information; Mankoff par. 24).

As per Claim 18. The service providing system of Claim 9, wherein the authentication information is transmitted to two or more portable terminals to authenticate the requested information sent to each portable terminal (at least paragraph Makoff 20-22).

Response to Arguments

5. Applicant's arguments filed 03 January 2008 have been fully considered but they are not persuasive. Applicant argues Mankoff does not disclose a portable terminal

having a second display area which displays only the authentication information which specifically identifies the information providing server and authentication information that can not be edited by the portable terminal.

Geiger teaches a client purchasing a content item and the delivery and enablement of the content item on the client mobile phone device display (col. 13:60-14:5). Thus, for example, using the embodiment of the current invention, the client would purchase a ticket and the ticket would be delivered and enabled by display on the client display. In combination with Mankoff, Mankoff teaches a user purchasing an electronic ticket (claim 18 lines 6-8) or being given a coupon (paragraph 32) which is then downloaded as an electronic ticket voucher including display data and authentication information suitable for displaying on the wireless device (claim 22). Geiger teaches a first display *area* for displaying the ticket on the portable terminal and a second display *area* of Mankoff teaching the coupon/ticket displaying a digital image watermark or code including an expiration date, for example (par. 32). It is also important to note that the claim limitations only list a first and second display *area*, and not two separate displays. As it is well known in the art that more than one item can be displayed on a display, the combination of Geiger with Mankoff teaches the limitations as claimed. Conversely, due to the broad wording of the claims, Mankoff could teach the first display area as in Fig. 2 where a listing of groups of the general coupon downloaded are displayed, and Mankoff teaches the claimed second display area as Fig. 3 wherein only the authentication information digital image is displayed, as the two display areas are not necessitated to be displayed simultaneously.

Mankoff teaches a coupon being represented by an unalterable digital image or watermark or the like for display on a display device such as a portable PDA. When a user wishes to redeem the coupon, the user displays the coupon on the PDA to be authenticated at such time (paragraph 32:1-7, 16-21). Thus, the digital image/watermark is displayed and is for authentication purposes.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Previously cited MLB.com, Na, Kobata, Martin et al, Kay, DeLaHueraga, Hale et al, Joyce et al (mobile voucher system with later filing date), Kiessling et al, Hamalainen et al, Kay, Katz et al, Talati et al, Hiroya et al, Ramasubramani et al, Hultgren and

Valtanen are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/G. G. T./
Examiner, Art Unit 2157

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157